

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85299987
LAW OFFICE ASSIGNED	LAW OFFICE 116
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The Examining Attorney has refused registration of the mark for certain products based on a prior registration for clothing. Although Applicant does not concede that any likelihood of confusion exists, and in fact, believes that the cited registration is vulnerable to cancellation for non-use, Applicant has now deleted all of the products from its application and limited its services to: "Entertainment services, namely, providing live musical performances; entertainment services, namely, appearances by a professional entertainer," in International Class 41. The Examining Attorney has specifically indicated in its prior actions that the refusal did not apply to such services. Moreover, it is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods or services as they are identified in the application and the registration. <u>Canadian Imperial Bank of Commerce v. Wells Fargo Bank</u>, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); <u>Paula Payne Products Co. v. Johnson Publishing Co., Inc.</u>, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). Applicant respectfully submits that the differences in the goods and services remove any chance of a likelihood of confusion. See <u>In re Sears Roebuck and Company</u>, 2 USPQ 2d 1312 (TTAB 1987). If goods and services are not marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect the incorrect assumption that they originate from the same source, then even if the marks are identical (here, they are certainly not), confusion is not likely. <u>Local Trademarks, Inc. v. Handyboys, Inc.</u>, 16 USPQ 2d 1156 (TTAB 1990); <u>Quartz Radiation Corp. v. Comm/Scope Co.</u>, 1 USPQ 2d 1668 (TTAB 1986).</p> <p>Accordingly, Applicant respectfully requests that the Examining Attorney approve the mark to publication in the Official Gazette at her earliest convenience. Applicant notes that it has today filed an Amendment to Allege Use for this application, and requests that it be processed simultaneously prior to approval, so that the mark will proceed directly to registration upon closing of the opposition period. If the Examining Attorney has any questions, she is urged to telephone the undersigned attorney.</p>	
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	041
DESCRIPTION	
Audio and video recordings featuring music and artistic performances; audio and video recordings featuring motion picture films, television programs, short films, how-to videos; audio and video recordings featuring information in the field of fashion; pre-recorded CDs and DVDs; downloadable audio and video recordings featuring music and artistic performances; downloadable audio and video	

recordings featuring motion picture films, television programs, short films, how-to videos; downloadable audio and video recordings featuring information in the field of fashion; computer game software; video game software; downloadable music via the Internet and wireless devices; audio and video recordings and digital media; jewelry, body jewelry, costume jewelry, watches, jewelry boxes, jewelry cases; clothing, namely, tops, bottoms, headwear, footwear, underwear, swimwear, shirts, pants, shorts, jackets, vests, tights, skirts, dresses, belts, purses, handbags, armbands; retail store services, online retail store services, and distributorship services featuring musical sound recordings, audio and video recordings, digital media, clothing, jewelry, watches, and fashion accessories; entertainment services in the nature of live musical performances; providing a website featuring information in the field of music, fashion and entertainment; providing a website allowing users to upload and download music and videos; entertainment services, namely, providing online computer games; entertainment services in the nature of motion picture films, television shows, short films, cartoons, and animation; entertainment services; educational services, namely, providing online information in the nature of tutorials in the field of fashion, music and entertainment; creating an online community for the purpose of entertainment, spirituality, self-help and personal empowerment; online social networking services; providing information in the field of music, entertainment and fashion; providing information in the field of spirituality, self-help and personal empowerment

FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	041
TRACKED TEXT DESCRIPTION	
<p>Audio and video recordings featuring music and artistic performances; audio and video recordings featuring information in the field of fashion; computer game software; video game software; downloadable music via the Internet and wireless devices; audio and video recordings and digital media; jewelry, body jewelry, costume jewelry, watches, jewelry boxes, jewelry cases; clothing, namely, tops, bottoms, headwear, footwear, underwear, swimwear, shirts, pants, shorts, jackets, vests, tights, skirts, dresses, belts, purses, handbags, armbands; retail store services, online retail store services, and distributorship services featuring musical sound recordings, audio and video recordings, digital media, clothing, jewelry, watches, and fashion accessories; entertainment services in the nature of live musical performances; providing a website featuring information in the field of music, fashion and entertainment; providing a website allowing users to upload and download music and videos; entertainment services, namely, providing online computer games; entertainment services in the nature of motion picture films, television shows, short films, cartoons, and animation; entertainment services; educational services, namely, providing online information in the nature of tutorials in the field of fashion, music and entertainment; creating an online community for the purpose of entertainment, spirituality, self-help and personal empowerment; online social networking services; providing information in the field of music, entertainment and fashion; providing information in the field of spirituality, self-help and personal empowerment</p> <p><u>Entertainment services, namely, providing live musical performances; entertainment services, namely, live appearances by a professional entertainer;</u></p>	
FINAL DESCRIPTION	

Entertainment services, namely, providing live musical performances; entertainment services, namely, live appearances by a professional entertainer	
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Lori S. Kozak/
SIGNATORY'S NAME	Lori S. Kozak
SIGNATORY'S POSITION	Attorney of Record, California Bar Member
SIGNATORY'S PHONE NUMBER	310.207.3800
DATE SIGNED	08/23/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Aug 23 18:29:12 EDT 2012
TEAS STAMP	USPTO/RFR-65.200.36.157-2 0120823182912132410-85299 987-4901df8165ce7b2b9cd4f 6f3946553ea-N/A-N/A-20120 823181849063420

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85299987** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The Examining Attorney has refused registration of the mark for certain products based on a prior registration for clothing. Although Applicant does not concede that any likelihood of confusion exists, and in fact, believes that the cited registration is vulnerable to cancellation for non-use, Applicant has now deleted all of the products from its application and limited its services to: "Entertainment services, namely, providing live musical performances; entertainment services, namely, appearances by a professional entertainer," in International Class 41. The Examining Attorney has specifically indicated in its prior actions that the refusal did not apply to such services. Moreover, it is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods or services as they

are identified in the application and the registration. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76 (CCPA 1973). Applicant respectfully submits that the differences in the goods and services remove any chance of a likelihood of confusion. See In re Sears Roebuck and Company, 2 USPQ 2d 1312 (TTAB 1987). If goods and services are not marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect the incorrect assumption that they originate from the same source, then even if the marks are identical (here, they are certainly not), confusion is not likely. Local Trademarks, Inc. v. Handyboys, Inc., 16 USPQ 2d 1156 (TTAB 1990); Quartz Radiation Corp. v. Comm/Scope Co., 1 USPQ 2d 1668 (TTAB 1986).

Accordingly, Applicant respectfully requests that the Examining Attorney approve the mark to publication in the Official Gazette at her earliest convenience. Applicant notes that it has today filed an Amendment to Allege Use for this application, and requests that it be processed simultaneously prior to approval, so that the mark will proceed directly to registration upon closing of the opposition period. If the Examining Attorney has any questions, she is urged to telephone the undersigned attorney.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 041 for Audio and video recordings featuring music and artistic performances; audio and video recordings featuring motion picture films, television programs, short films, how-to videos; audio and video recordings featuring information in the field of fashion; pre-recorded CDs and DVDs; downloadable audio and video recordings featuring music and artistic performances; downloadable audio and video recordings featuring motion picture films, television programs, short films, how-to videos; downloadable audio and video recordings featuring information in the field of fashion; computer game software; video game software; downloadable music via the Internet and wireless devices; audio and video recordings and digital media; jewelry, body jewelry, costume jewelry, watches, jewelry boxes, jewelry cases; clothing, namely, tops, bottoms, headwear, footwear, underwear, swimwear, shirts, pants, shorts, jackets, vests, tights, skirts, dresses, belts, purses, handbags, armbands; retail store services, online retail store services, and distributorship services featuring musical sound recordings, audio and video recordings, digital media, clothing, jewelry, watches, and fashion accessories; entertainment services in the nature of live musical performances; providing a website featuring information in the field of music, fashion and entertainment; providing a website allowing users to upload and download music and videos; entertainment services, namely, providing online computer games; entertainment services in the nature of motion picture films, television shows, short films, cartoons, and animation; entertainment services; educational services, namely, providing online information in the nature of tutorials in the field of fashion, music and entertainment; creating an online community for the purpose of entertainment, spirituality, self-help and personal empowerment; online social networking services; providing information in the field of music, entertainment and fashion; providing information in the field of spirituality, self-help and personal empowerment

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Audio and video recordings featuring music and artistic performances;~~ Entertainment services, namely, providing live musical performances; ~~audio and video recordings featuring motion picture films, television programs, short films, ?how-to? videos;~~ entertainment services, namely, live appearances by a professional entertainer; ~~audio and video recordings featuring information~~

~~in the field of fashion; pre-recorded CDs and DVDs; downloadable audio and video recordings featuring music and artistic performances; downloadable audio and video recordings featuring motion picture films, television programs, short films, ?how-to? videos; downloadable audio and video recordings featuring information in the field of fashion; computer game software; video game software; downloadable music via the Internet and wireless devices; audio and video recordings and digital media; jewelry, body jewelry, costume jewelry, watches, jewelry boxes, jewelry cases; clothing, namely, tops, bottoms, headwear, footwear, underwear, swimwear, shirts, pants, shorts, jackets, vests, tights, skirts, dresses, belts, purses, handbags, armbands; retail store services, online retail store services, and distributorship services featuring musical sound recordings, audio and video recordings, digital media, clothing, jewelry, watches, and fashion accessories; entertainment services in the nature of live musical performances; providing a website featuring information in the field of music, fashion and entertainment; providing a website allowing users to upload and download music and videos; entertainment services, namely, providing online computer games; entertainment services in the nature of motion picture films, television shows, short films, cartoons, and animation; entertainment services; educational services, namely, providing online information in the nature of tutorials in the field of fashion, music and entertainment; creating an online community for the purpose of entertainment, spirituality, self-help and personal empowerment; online social networking services; providing information in the field of music, entertainment and fashion; providing information in the field of spirituality, self-help and personal empowerment~~

Class 041 for Entertainment services, namely, providing live musical performances; entertainment services, namely, live appearances by a professional entertainer

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Lori S. Kozak/ Date: 08/23/2012

Signatory's Name: Lori S. Kozak

Signatory's Position: Attorney of Record, California Bar Member

Signatory's Phone Number: 310.207.3800

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85299987

Internet Transmission Date: Thu Aug 23 18:29:12 EDT 2012

TEAS Stamp: USPTO/RFR-65.200.36.157-2012082318291213

2410-85299987-4901df8165ce7b2b9cd4f6f394
6553ea-N/A-N/A-20120823181849063420